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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,929	07/09/2001	Takaaki Murata	02887.0144-01	7152

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EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/899,929

Applicant(s)

MURATA ET AL.

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-22 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/377,485.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group III (claims 36-44) in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 20-22 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.
3. Upon further consideration, the examiner has decided to withdraw the restriction requirement between Species in Group III. Therefore, all claims 36-44 of Group III are being examined together.

Specification

4. The disclosure is objected to because of the following informalities: there is no support for the hot electrode and additional electrodes being on opposite surfaces of the dielectric substrate in claim 44.

Appropriate correction is required.

Claim Objections

5. Claim 39 is objected to because of the following informalities: line 2, "two" should be deleted. Appropriate correction is required.

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6. Claim 44 is objected to because of the following informalities: line 7, "holt" should be changed to --hot--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 36-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 is indefinite because of the use of "including" in line 2. It is unclear to the examiner whether Applicants mean to indicate the ozonizing unit or the electrode plate including the limitations following the word. Clarification of this structural relationship is required.

9. Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 44 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found on page 66 of the specification and Figure 59. In the specification and Figure 59, applicant has shown that the hot electrode and the additional electrode are on the front surface of the dielectric substrate; i.e. both electrodes are on the same surface of the dielectric substrate. The specification and Figure 59, thus, indicate that the invention is different from what is defined in the claim(s) because instant claim 44 conveys that the two electrodes can be on the same surface, or on opposite surfaces of the dielectric substrate.

Remark

10. In light of the specification, the examiner is interpreting that the electrode plate in claim 36 includes the limitations following the word “including”.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 36, 38-40, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyagawa et al. (US Pat. 4,626,876).

In regards to claims 36 and 39-40, Miyagawa teaches an ozonizing unit (ozone generator) comprising an electrode plate, the electrode plate including a dielectric substrate 1, a hot electrode and a stray electrode 2 and 3 (floating electrodes) formed on one surface of the dielectric substrate; and a back electrode 5 formed on the other surface of the dielectric substrate (see Fig. 4-10; col. 3, ln. 64 to col. 4, ln. 14). Miyagawa further teaches the electrodes, each having linear electrode elements 2, 2', 3, 3', and 5 (see Fig. 12); the linear elements of the stray electrode are interposed between those of the hot electrode.

In regards to claim 44, the additional electrode could be interpreted as one of the floating electrodes or the back electrode in claim 36.

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In regards to claim 38, Miyagawa teaches the hot and stray electrodes being covered by a dielectric (see Figs. 5-6, 8-10).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 37 and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyagawa as applied to claim 36 above.

Miyagawa is as set forth in claim 36 above and incorporated herein.

In regards to claim 37, Miyagawa teaches the back electrode covering a major part of the surface of the dielectric (see Fig. 7).

Although Miyagawa does not teach the back electrode covering the whole surface of the dielectric, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have modified Miyagawa's back electrode so that the electrode would cover the whole surface of the dielectric, because it appears that whether the back electrode covers the whole surface of a major part of the surface of the dielectric would not have significantly changed the operation of the ozonizing unit. See In re Kuhle, 188 USPQ 7 (CCPA 1975); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

In regards to claim 41, although Miyagawa does not teach the dielectric substrate being circular, the hot and stray electrode elements being concentric circles or a pattern of spiral; it

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would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the shapes of the dielectric and the electrode elements would have been an obvious design choice, since Applicant has not disclose that those particular configurations would improve the process or is of any particular purpose. See *In re Dailey*, 149 USPQ 47 (CCPA 1966); *In re Kuhle* 188 USPQ (CCPA 1975).

In regards to claims 42-43, Miyagawa teaches an ozonizing unit (ozone generator) comprising an electrode plate, the electrode plate including a dielectric substrate 1, a hot electrode and a stray electrode 2 and 3 formed on one surface of the dielectric substrate; and a back electrode 5 formed on the other surface of the dielectric substrate (see Fig. 4-10; col. 3, ln. 64 to col. 4, ln. 14). Miyagawa further teaches the electrodes, each having linear electrode elements 2, 2', 3, 3', and 5 (see Fig. 12).

Although Miyagawa teaches the linear elements of the back electrode being parallel to, instead of intersecting, the hot and stray electrode elements; it has been held mere rearrangement of parts an obvious matter of design choice and, therefore, unpatentable, because rearrangement the position of the electrode elements with respect to each other would depend upon operating conditions and user's preference and intended use. See *In re Kuhle*, 188 USPQ 7 (CCPA 1975); *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Contact Information

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 703-306-5698. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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March 11, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700